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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,191	01/23/2004	James Charles Dunbar	CM2596MC	8065

27752 7590 03/16/2005

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EXAMINER

ELHILO, EISA B

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,191

Applicant(s)

DUNBAR ET AL.

Examiner

Eisa B Elhilo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1 This action is responsive to the amendment filed on January 7, 2005.

2 The rejection of claims 12-14 under 35 U.S.C. 112, 2nd paragraph, is withdrawn because
of the applicant's amendment.

3 The rejection of claims 1-17 under 35 U.S.C. 103(a) as being unpatentable over Pratt et
al. (WO 98/52519) in view of Audousset et al. (US 5,578,087), is maintained for the reasons set
forth in the previous office action mailed on 10, 7, 2004.

Response to Applicant's Arguments

4 Applicant's arguments filed 10/7/2004 have been fully considered but they are not
persuasive.

With respect to the rejection of the claims under 35 U.S.C. 103(a) over Pratt et al. (WO' 519) in view of Audousset et al. (US' 087), Applicant argues that the combination of Pratt and Audousset does not establish a prima facie case obviousness because there is no suggestion or motivation to modify the cited references to achieve Applicants' hair coloring composition. Applicant also argues that Pratt teaches away from using a developer, which is capable of undergoing more than one nucleophilic attack reaction, such as unsubstituted para-phenylenediamine. Applicant further, argues that Audousset discloses both para-phenylenediamine (an Unsubstituted amine compound which is capable of undergoing at least two electrophilic attack reaction) and N,N-bis (β -hydroxyethyl) para-phenylenediamine (a substituted amine compound which is capable of undergoing a single electrophilic attack reaction) but Audousset fails to disclose any benefit in selecting one of the suitable developers over another from among the extensive list disclosed and therefore, there is no suggestion or

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motivation to additionally incorporated para-phenylenediamine in the composition of Pratt to achieve Applicants' claimed composition.

The examiner respectfully disagrees to the above arguments because of the following reasons.

(I) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(2) Pratt et al. (WO' 519) as a primary reference teaches a hair coloring composition comprising a developer of N,N-disubstituted p-phenylene that capable of undergoing only a single electrophilic attack reaction (see page 24, lines 24-29) and couplers of N,N-dimethyl acetamide and diethyl acetoacetamide that read on the claimed formula (I) (see page 15, lines 10-12). Audousset et al. (US' 087) as a secondary reference clearly teaches that the developers of para-phenylenediamine (unsubstituted amine compound) and N,N-bis (β -hydroxyethyl) para-phenylenediamine (a substituted amine compound) are both applicable and can be used in the hair coloring composition (see col. 3, lines 13-23). Therefore, there is a sufficient motivation to one having ordinary skill in the art to incorporate the p-phenylenediamine that undergoing at least two electrophilic reactions as taught by Audousset et al. in the composition of Pratt et al. (WO' 519) with the reasonable expectation of achieving a performance coloring composition. Therefore, the prima facie case of obviousness has been established.

(3) The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature

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of the art, relevant for all they contain. “*In re Heck*, 699 F.2d 1331, 1332-33 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Iemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). Furthermore, a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed.Cir.), *cert. denied*, 493 U.S. 975 (1989).

With respect to the applicants’ argument based on the comparative data in Examples 1 and 2 at page 11 of specification to demonstrate the unexpected and unobvious results of the claimed invention over the composition of the prior art, the examiner’s position is that the provided data is not commensurate in the scope with the composition of the prior art (WO’ 519), because the prior art (WO’ 519) teaches a composition comprising 4-(N-ethyl, N-hydroxyethyl-p-phenylenediamine in combination with N,N-diethylacetoacetamide (see page 64, compositions III and IV) and does not exemplify dicloropara-aminophenol (DCP) that used in the comparative data in examples 1 and 2.

5 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

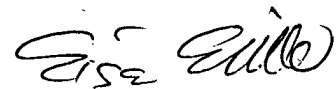
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eisa Elhilo
Patent Examiner
Art Unit 1751

March 9, 2005